

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEAL
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SETHURAMAN SURESH,
RICHARD KAHN and JOHN S. BAUMGARTEN

Appeal No. 2001-1021
Application No. 08/923,612

ORDER REMANDING TO EXAMINER

On March 20, 2000, appellants filed a Notice of Appeal (Paper No. 11) from the Office action dated October 14, 1999 (Paper No. 9) finally rejecting claims 1-27 [sic, 1-25] and 27-30. The Appeal Brief filed August 24, 2000 (Paper No. 13) stated:

Claims 1-25 and 27-30 are pending in the subject application and are the subject of

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this appeal [page 3 under the heading "Status of Claims".

The Examiner's Answer mailed September 18, 2000 (Paper No. 14) made the following rejections:

1. Claims 1-13 under 35 U.S.C. 103(a) as being unpatentable over Kucala, further in view of Olds;
2. Claims 14-17 under 35 U.S.C. 103(a) as being unpatentable over Kucala and Olds, further in view of Buchanan; and
3. Claims 21-25, 27-30 as being unpatentable over Meyering, further in view of Olds.

It should be noted that the Examiner's Answer failed to specifically reject claims 18-20.

In addition, on page 3 of the Examiner's Answer, the examiner listed the following references under the heading "(9) Prior Art of record"):

5,727,202	Kucala	10 Mar. 1998
5,832,487	Olds et al.,	3 Nov. 1998
5,758,355	Buchanan	26 May 1998

It is noted that the Meyering reference cited on pages 11-14 of the Examiner's Answer under the heading "(11) Grounds of Rejection" is not included as "Prior Art of Record." In

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accordance with § 1211 of the Manual of Patent Examining Procedure (MPEP) (7th Ed., Rev. 1, Feb. 2000), clarification is required regarding the pertinence of the Meyering reference. In addition, MPEP § 1208(A)(9) states:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.
The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(9) References of Record. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

If appropriate, compliance with MPEP § 1208(A)(9) is required in listing the Meyering reference under the heading "Prior Art of Record" appearing in the Examiner's Answer mailed September 18, 2000 (Paper No. 14).

Accordingly, it is

ORDERED that the application is remanded to the examiner:

1. for a determination regarding the status of claims 18-20;

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2. for clarification under MPEP § 1211 regarding the pertinence of the Meyering reference listed on pages 11-14 of the Examiner's Answer (Paper No. 14);

3. if appropriate, for compliance with MPEP § 1208(A)(9) by listing the Meyering reference in a Supplemental Examiner's Answer under the heading "References of Record"; and

4. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

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